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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/159,843	09/24/98	MELBY	A C-2047DA

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IM81/0311

EXAMINER

MICHL, F

ART UNIT	PAPER NUMBER
1714	7

DATE MAILED: 03/11/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 3/1/99

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-8, 10, 14 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8, 10, 14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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Claims 1-8, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peiffer '916. The Examiner's position remains as stated in the November 25 Office action. Applicants' arguments have been considered but are not persuasive. Applicants argue that Peiffer discloses terpolymers of acrylamide, metal styrene sulfonate, and MAPTAC. This argument is not persuasive because Peiffer specifically recites methacrylic acid, acrylic acid, and acrylamido methylpropane sulfonic acid in column 2, lines 29-33. Peiffer teaches that acrylic acid, methacrylic acid, and acrylamido methylpropane sulfonic acid are functionally equivalent to sodium styrene sulfonate for the purposes of his terpolymers. Therefore, terpolymers of acrylamide, MAPTAC, and either acrylic acid or methacrylic acid or acrylamido methylpropane sulfonic acid would be prima facie obvious. A prima facie case of obviousness may be obviated by a showing of unexpectedly superior properties. However, applicants have not submitted the proper showing in affidavit or declaration form. The proper showing would be a comparison of the properties of a terpolymer of acrylamide, MAPTAC, and either acrylic acid or methacrylic acid or acrylamido methylpropane sulfonic acid compared to the properties of a terpolymer of acrylamide, MAPTAC, and sodium styrene sulfonate. The Declaration submitted by applicants March 1, 1999 has been considered but is deemed to be of no probative value. The

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Declaration is not directed to the claimed invention. The Declaration is not commensurate in scope with the claimed invention. The claimed invention is a "polymer". The Declaration is directed to various compositions containing the polymer. Applicants' claims are not directed to compositions containing the polymer. Applicants' claims are directed to the polymer per se. The Examiner agrees with applicants' assertion that the properties of a compound are to be considered in evaluating the patentability of the compound. However, applicants have not presented any evidence in affidavit or declaration form showing the properties of the claimed polymer. Applicants have only shown properties of compositions containing the polymer. Applicants have not presented claims directed to these compositions containing the polymer. The argument that Peiffer is non-analogous art is not persuasive. Peiffer is directed to the same field of endeavor as applicants' claims. Applicants' claims are directed to "polymer". Peiffer is directed to "polymer". Therefore Peiffer and applicants are directed to the same field of endeavor. Applicants argue concerning "one skilled in the art of cosmetic formulations and uses thereof". This argument is not persuasive because applicants' field of endeavor is not directed to "cosmetic formulations and uses thereof". Applicants' field of endeavor is directed to "a polymer". Applicants' claims recite "ampholyte".

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This limitation is met because Peiffer discloses "polyampholyte".

Claims 1-8, 10, and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of Patent No. 5,879,670. The Examiner notes applicants' intention to submit a terminal disclaimer.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry concerning this communication should be directed to Paul Michl at telephone number (703) 308-2451.

The Examiner's supervisor is Vasu Jagannathan phone number (703) 306-2777. The fax number for this group is (703) 305-3599.

PRMichl:cdc

(703) 308-0661

March 11, 1999


PAUL R. MICHL
PATENT EXAMINER
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